

Appln. No.: 09/640,103  
Amendment Dated December 30, 2004  
Reply to Office Action of July 30, 2004

FKC-100US

**Remarks/Arguments:**

Claims 1-16 are pending in the above-identified application. Claims 14-16 are newly added. Basis for these newly added claims may be found in claims 1, 8 and 9. No new matter is added by these amendments.

The specification was objected to because reference character 12 was used to designate "email," "web form" and "SMS." This objection is overcome by the amendments to the drawings which respectively change "email," "web form" and "SMS" to "email msg," "web form msg" and "SMS msg," to emphasize that these are different types of messages. Messages are generically identified by reference character 12 in the specification. Basis for this amendment may be found at page 7, line 31 through page 8, line 6. In addition, Fig. 1 has been amended to include the reply message 13 and the mail client 21. Basis for this amendment may be found in Fig. 2 and at page 10, line 19 through page 11, line 2. It is noted that "reply" is a synonym of "response." Thus, one of ordinary skill in the art would understand that the reply message shown in amended Fig. 1 corresponds to the response message referenced in the cited passage. No new matter is added by these amendments.

The specification was objected to as including "numerous grammatical errors in the specification and the claim." Applicant has reviewed the specification and claims and has corrected several errors by this amendment. In addition, the title was objected to as being non-descriptive. A new title is included in this amendment.

In view of these amendments to the drawing and the specification, the drawings and the specification are no longer subject to objection.

Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. In particular, the Examiner objected to the use of the phrase "the or each." Applicant has amended claims 1 and 2 to replace the phrase "the or each" with the equivalent phrase "at least one." With this amendment, claims 1 and 2 are no longer subject to rejection under 35 U.S.C. § 112, second paragraph.

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Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Buskirk and Eichstaedt. This ground for rejection is respectfully traversed. In particular, neither Buskirk, Eichstaedt nor their combination disclose or suggest, "wherein the at least one result generated by application of the at least one rule set to the message content determines at least one next rule set to be applied," as required by claims 1 and 8, or the step of "causing the at least one text analyzer, in association with the associated rule engine, to apply at least one rule set of the plurality of rule sets to the message content in accordance with a hierarchy," as required by claim 9. Newly added claims 14, 15 and 16 include similar recitations.

In the Office Action, it is acknowledged that Buskirk does not disclose or suggest applying the one or more rule sets to the message content in accordance with a hierarchical structure. It is asserted, however, that Eichstaedt teaches this feature. In particular, it is asserted that this feature is disclosed in the Abstract, Fig. 1 and column 1, lines 35-55 of Eichstaedt. Applicant respectfully disagrees with this assertion.

Eichstaedt discloses two types of hierarchy. The first is the hierarchical structure of a document which is described by Eichstaedt at column 1, lines 35-55 and at column 2 lines 22-41. By way of example, Eichstaedt describes the 3-level document structure for a patent document, the three levels being "title", "abstract" and "detailed description".

The second hierarchy is a hierarchical taxonomy tree (as shown in Figure 1 of US 6,385,619) comprising classes to which documents can be assigned. Eichstaedt describes the taxonomy tree of Figure 1 at column 2 lines 42-55 and cites the US Patent Class Definitions as an example of such a taxonomy.

Neither of the hierarchies disclosed by Eichstaedt relates to the application of rules to message content, nor do they even relate to rules *per se*. Moreover, the Eichstaedt document in general is not concerned with the application of rules to message content. Therefore, Eichstaedt does not teach the application of rules to message content in accordance with a hierarchical structure.

Furthermore, because Eichstaedt does not concern message processing, rules or the hierarchical application of rules, the only motivation to combine Eichstaedt with Buskirk

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impermissibly comes from Applicant's own disclosure. It is well settled that Applicant's disclosure may not be used against him in this way.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* (emphasis added)<sup>1</sup>

Accordingly, neither Buskirk nor Eichstaedt disclose, individually or collectively, a system having any of the following features:

1. Rules arranged into a plurality of rule sets.
2. A classification module being arranged to cause the text analyser in association with the rule engine to apply at least one rule set to the message content in accordance with a hierarchical structure.
3. Wherein the at least one result is generated by application of a rule set to the message content determines the at least one next rule set to be applied.

It is therefore respectfully submitted that Claims 1, 8, 9 and 14 to 16 are not subject to rejection under 35 U.S.C. § 103(a) in view of Buskirk and Eichstaedt. Claims 2-7 and 11-13 are dependent directly or indirectly on Claim 1, and claim 10 is dependent on Claim 9. Consequently, these claims are not subject to rejection under 35 U.S.C. § 103(a) in view of Buskirk and Eichstaedt for at least the same reasons as the claims from which they depend. Newly added claims 14-16 include similar recitations to claims 1, 8 and 9 and are not subject to rejection under 35 U.S.C. § 103(a) in view of Buskirk and Eichstaedt for at least these same reasons.

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<sup>1</sup> MPEP §706.02(j)

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In view of the foregoing amendments and remarks, Applicant requests that the Examiner reconsider and withdraw the objections to the drawings and specification and the rejection of claims 1-13. Applicant also requests that newly added claims 14-16 be allowed.

Respectfully submitted,

  
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Attachments: Figure 1 (1 sheet)

Dated: December 30, 2004

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Tonya M. Berger

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